

REMARKS

Claims 1-9 and 11-17 are pending in this application. Claims 1-9 and 11-17 have been rejected under 35 U.S.C. §103 as obvious over Pepe et al. (US Pat. No. 5,742,905) in view of Seazholtz et al. (US Pat. No. 5,333,173). Claim 1 recites as follows, with emphasis added:

1. A system for providing voice messaging to stations connected to different communication networks comprising:

- a plurality of voice mailboxes;
- a first network interface receiving a request to leave a message for a first station, said first station being associated with a first mailbox;
- a second network interface receiving a request to leave a message for a second station, said second station being associated with said first mailbox; and
- a message waiting indication generator, said generator coupled to said first and said second network interface and transmitting a message waiting indication to both said first station and said second station substantially simultaneously over the first and second communication networks.

For the reasons discussed below, the Applicants respectfully request the withdrawal of the rejections of claims 1, 7 and 13.

1. Pepe does not teach two stations associated with the same mailbox

The specification for the current application explains that, in accordance with the present invention, there is a single voice mailbox for the subscriber "which will receive messages directed to either one or both of the telephone instruments 112 and 201." In addition, the specification also explains that there may be two telephone numbers of a given mailbox. *See* Specification at page 4, lines 23-31 ("Thus there are two access points to the mailbox."). Accordingly, claim 1 recites a system in which a "first station" and a "second station" are both on different networks and are both associated with the same "first mailbox." Similarly, claim 7 recites a system in which each mailbox is associated with two stations with a message waiting notification sent to both stations, and claim 13 recites a method that includes associating a mailbox with two stations and transmitting a message waiting notification to both stations. Pepe does not disclose this feature of claims 1, 7 and 13.

In the Office Action mailed January 5, 2000, the Examiner stated that Pepe teaches a system with a "second mobile station . . . associated with said first subscriber mailbox." See Office Action at page 3. Applicants submit, however, that while a user of the system in Pepe may use a wireless phone or a wireline phone, they are not different stations within the meaning of claims 1, 7 and 13 because these phones have the same phone number. Pepe states that "[t]he mobile communications subscriber can receive e-mail, fax, pages, and voice messages under *a single phone number* while using either a wireless or wireline network." Col. 5, lines 59-62 (emphasis added). The wireless and wireline phones therefore do not act as independent stations. Thus, Pepe does not teach a second station and a first station both associated with the same mailbox as recited in claims 1, 7 and 13.

2. Neither Pepe nor Seazholtz teach transmitting a "message waiting indication" to both stations substantially simultaneously

Claim 1 recites that a "message *waiting* indication" is transmitted to both stations substantially simultaneously. Similarly, claim 7 recites a system in which a message waiting notification is sent to both stations substantially simultaneously, and claim 13 recites a method that includes transmitting a message waiting notification to both stations substantially simultaneously.

As the examiner noted at the interview on October 12, 1999, Pepe does not teach transmitting a message waiting notice to both stations as recited in claims 1, 7 and 13. While Pepe teaches cross-media notification of messages, such as the sending of message notification via e-mail to a personal digital assistant (col. 20, lines 42-54), it does not teach sending "message waiting indication" to both the telephone instrument on the wireless network and the telephone instrument on the wired network.

In the Office Action mailed January 5, 2000, the Examiner stated that Seazholtz teaches "a voice mail system which is used for simultaneous notification of a subscriber's message to different called parties." See Office Action at page 3. Applicants respectfully submit, however, that Seazholtz does not teach or suggest "notification of a subscribers message" (as the examiner stated) or transmitting a "message waiting indication" to both stations substantially simultaneously (as is recited in claims 1, 7, and 13). Rather, Seazholtz teaches a personal check-up service that periodically places telephone calls to a person in need of surveillance, such as an

elderly person. Col. 1, lines 29-42. If the person under surveillance does not answer the telephone calls, the system sends a “notification message” to person on a list, such the grown children of the elderly person under surveillance. Col. 2, lines 17-24. The “notification message” disclosed in Seazholtz is not a “message waiting indication” within the meaning of claims 1, 7 and 13 because it does not notify anyone that a message is *waiting*. Instead of notifying them that there is a message, Seazholtz’s notification message notifies persons that “an immediate care situation exists.” Col. 2, lines 25-27. The notification message contains all of the pertinent information that the system knows (e.g., that the person under surveillance did not answer their phone), and once a person on the list receives such a notification message there is no further message or information that the system can give them.

3. There is no actual evidence of a suggestion to combine Pepe and Seazholtz

Finally, even assuming that Pepe and Seazholz taught or suggested all of the limitations of claims 1, 3 and 7, the rejection of these claims as obvious over Pepe and Seazholz was not proper because the Examiner has not shown “actual evidence” that there would have been a motivation for combining these references. *See In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (holding that an examiner is required to show “actual evidence” of a motivation to combine references). Rather, the Examiner has stated that it would have been obvious to combine Pepe and Seazholz because the references are “in analogous notification activities.” *See* Office Action at page 3. While references must be analogous to be combined for obviousness purposes, simply being analogous does not provide a motivation for combining the references—if it did, the requirement that there be a motivation to make a case of obviousness would be of almost no consequence. Rather, to make a prima facie case of obviousness, the examiner must show actual evidence that there is some reason a person of ordinary skill in the art would have wanted to combine the teachings.

Moreover, for the reasons discussed above, Pepe and Seazholz do not teach “analogous notification activities.” In particular, Seazholz is directed at providing a notification message that informs called parties that a person under surveillance has not answered a phone call. It does not notify anyone there is a message waiting.

4. Conclusion

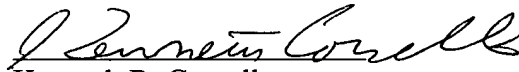
For at least the above reasons, it is believe that claims 1, 7 and 13 represent patentable subject matter over Pepe. Removal of the rejections with respect to these claims is respectfully requested. Further, dependent claims 2-6, 8-12, and 14-17 all depend from claims 1, 7 or 13. Therefore, these claims are patentable for at least those reasons presented for claims 1, 7 and 13. Removal of the rejections with respect to these claims is respectfully requested.

In view of the above, it is believed that all claims remaining in this application are in condition for allowance, prompt notice of which is respectfully solicited. The Office is authorized to charge any fees or credit any overpayment to Kenyon & Kenyon Deposit Account No. 11-0600.

The Examiner is invited to call the undersigned at (202) 220-4310 to discuss any matter concerning this application.

Respectfully submitted,

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